



Image 2833
402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy : Examiner B. Hammond
Serial No. 08/951,276 : Group Art Unit: 2833
Filed: October 16, 1997 :
Title: Retractable Receptacle :
For Furniture :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION

Applicant respectfully requests reconsideration of both the objection to the drawing and the prior art rejection of the claims, made in the Official Action dated December 15, 2003.

In the Request For Reconsideration filed on June 11, 2003, Applicant requested that the prior art rejections made in the Official Action dated March 7, 2003 be withdrawn in view of a "Petition to Commissioner Under 37 C.F.R. 1.181", filed on April 15, 2003. In the Official Action dated December 15, 2003, the Examiner states, at page 5, paragraph 6 that the arguments

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Mark P. Stone
MARK P. STONE
Reg. No. 27,954

3/12/04
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presented in the Request For Reconsideration filed on June 11, 2003 regarding Claims 1 - 20 are not persuasive because Applicant's Petition to the Commissioner was denied. The arguments presented in the Request For Reconsideration filed June 11, 2003 addressed the drawing objection in the Official Action dated March 7, 2003, were not considered by the Examiner in the December 15, 2003 Official Action. The substance of the Official Action dated December 15, 2003 is identical to that of the Official Action dated March 7, 2003, which was addressed by Applicant in the Request For Reconsideration filed on June 11, 2003.

With regard to the prior art rejections of Claims 1 - 20 raised in the latest Official Action which, as indicated above, are identical to the prior art rejections raised in the Official Action dated March 7, 2003, Applicant notes that there has been no final adjudication of the Petition to Commissioner filed on April 15, 2003. Applicant believes that the Decision On Petition dated November 19, 2003 is erroneous, and Applicant has timely filed a "Request For Reconsideration Of Decision On Petition By Technology Center Director", on December 11, 2003.

Enclosed for the convenience of the Examiner is a copy of Applicant's Request For Reconsideration of the Decision on the Petition. Applicant again requests that the prior art rejections raised in the Official Action dated December 15, 2003 be reconsidered and withdrawn for the reasons addressed in the

original Petition to Commissioner filed on April 15, 2003, and in the Request For Reconsideration Of Decision On Petition By Technology Center Director filed on December 11, 2003. For the reasons discussed in both the original Petition and the Request For Reconsideration Of Decision On Petition, Applicant submits that it is improper to reject the pending claims based upon the prior art applied in the Official Action dated December 15, 2003. Applicant therefore responds to prior art rejections of Claims 1 - 20 in the Official Action dated December 15, 2003 by incorporating by reference, in their entireties, both the "Petition To Commissioner Under 37 C.F.R. 1.181" filed on April 15, 2003, and the "Request For Reconsideration Of Decision On Petition By Technology Center Director" filed on December 11, 2003.

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At pages 3 - 5 of the Request For Reconsideration filed on June 11, 2003, Applicant presented arguments in response to the objection to the drawing raised at paragraph 2 of the Official Action dated March 7, 2003 (which is identical to paragraph 2 of the Official Action dated December 15, 2003). In the Official Action dated December 15, 2003, the Examiner has failed to address or consider any of the arguments advanced by Applicant in the Request For Reconsideration filed on June 11, 2003 regarding the drawing objection. Applicant respectfully incorporates by reference the arguments advanced at pages 3 - 5 of the Request

For Reconsideration filed on June 11, 2003 in response to the objection to the drawing repeated at paragraph 2 of the Official Action dated December 15, 2003. Applicant respectfully requests that the objection to the drawing be reconsidered and withdrawn for the reasons advanced by Applicant, which have not yet been addressed by the Examiner.

For the reasons discussed herein, during the prosecution of this patent application, in the original Petition to Commissioner and in the Request For Reconsideration Of Decision On Petition, Applicant respectfully requests that the prior art rejections raised against the claims after the Decision on Appeal, as repeated in the latest Official Action, and the prior objection to the drawing, as repeated in the latest Official Action, be reconsidered and withdrawn, and that this patent application be allowed.

Also is a copy of a Change Of Attorney's Correspondence Address, previously filed in connection with this patent application. Please correct the Patent & Trademark Office file for this application to indicate the undersigned attorney's current correspondence address.

Respectfully submitted,



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Attorney for Applicant
25 Third Street, 4th Floor
Stamford, CT 06905
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402-038-19

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Serial No. 08/951,276 : Group Art Unit: 2833
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Title: Retractable Receptacle :
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CHANGE OF ATTORNEY'S CORRESPONDENCE ADDRESS

The correspondence address of the attorney of record for the above identified patent application has been changed to the following:

Mark P. Stone
25 Third Street
4th Floor
Stamford, CT 06905
Tel. (203) 329-3355
Fax. (203) 329-3729

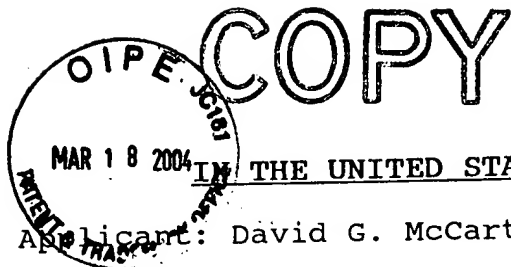
Please address all further correspondence and direct all further telephone calls regarding this patent application to the address and telephone number indicated above.

Respectfully submitted,

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Attorney for Applicant
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(Date of Deposit)



402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy : Examiner B. Hammond
Serial No. 08/951,276 : Group Art Unit: 2833
Filed: October 16, 1997 :
Title: Retractable Receptacle :
For Furniture :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Box DAC
Office of Petitions

REQUEST FOR RECONSIDERATION OF DECISION
ON PETITION BY TECHNOLOGY CENTER DIRECTOR

The above identified Applicant, by and through his undersigned attorney, hereby requests review of the Decision On Petition dated November 19, 2003 (copy enclosed), by the Director of Technology Center 2800.

On April 15, 2003, a Petition to Commissioner Under 35 CFR 1.181 (copy enclosed) was filed requesting that the decision in the Official Action dated March 7, 2003, to re-open prosecution on the merits after appeal, be vacated. As more fully discussed

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in the Petition filed on April 15, 2003, Applicant filed a Notice of Appeal in response to a final rejection by the Primary Examiner dated August 31, 1999, raising both prior art and formal grounds of rejection. Applicant's Appeal Brief addressed both the prior art and the formal grounds of rejection, and the Examiner's Answer expressly withdrew the prior art grounds of rejection. The Board of Patent Appeals And Interferences reversed the formal grounds of rejection but the Examiner re-opened prosecution on the merits raising prior art rejections based upon the same prior art references applied in the final rejection dated August 31, 1999.

In the Petition filed on April 15, 2003, Applicant argued that the re-opening of the prosecution on the merits after appeal to reject the appealed claims on prior art known to and applied by the Examiner prior to the Appeal, where all prior art rejections made prior to the filing of the appeal were expressly withdrawn by the Examiner, violates 37 CFR 1.198 because 1). the grounds of prior art rejection raised by the Primary Examiner in the reopened prosecution have already been adjudicated by the Board (by default), and 2). because the Primary Examiner has failed to show good cause why prosecution should now be reopened to reject claims over identical prior art known to the Examiner prior to the filing of the appeal and expressly withdrawn by the Examiner prior to decision by the Board, as are more fully addressed at Section III, starting at page 3 of Applicant's Petition filed on April 15, 2003.

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The Decision on Petition dated November 19, 2003, states that the Board only adjudicated the formal grounds of rejection, and never adjudicated the rejection of the claims over the prior art. However, this occurred only because the Examiner expressly withdrew the prior art rejections in the Examiner's Answer prior to the decision on appeal, but allowed the appeal to proceed based only on the formal grounds of rejection.

The Decision On Petition states "...no where in the record is it indicated that the claims were allowable over the prior art of record." Applicant respectfully disagrees. The fact that the Examiner withdrew all prior art rejections in the Examiner's Answer (in response to the arguments advanced by Applicant in the Appeal Brief that the claims are allowable over the prior art applied in the final action), and that the Examiner allowed the appeal to proceed based only on the formal grounds of rejection is, at the least, an implicit admission that the Examiner considered the appealed claims to be allowable over the prior art of record.

The Decision On Petition dated November 19, 2003, also states that "...the new grounds of rejection under 35 U.S.C. Section 103 show sufficient cause to warrant the reopening of prosecution". However, the Decision On Petition fails to provide any explanation why the new grounds of rejection, which are based upon the identical prior art references cited and applied in the Final Action dated August 31, 1999, were not made by the Examiner

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prior to Decision by the Board on Appeal, particularly when the Examiner expressly withdrew all prior art rejections in the Final Action but allowed the Appeal to proceed based only on the formal grounds of rejection.

Applicant respectfully submits, for the reasons addressed in the Petition filed on April 15, 2003, that the reopening of prosecution on the merits after decision by the Board for the purpose of raising prior art rejections based on the identical prior art references applied by the Examiner prior to the Appeal, which were expressly withdrawn by the Examiner prior to the decision by the Board, violates 37 CFR 1.198.

Applicant respectfully requests reconsideration and reversal of the Decision On Petition, dated November 19, 2003, denying Applicant's Petition filed on April 15, 2003.

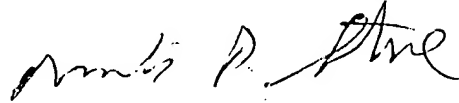
Enclosed are copies of Petition filed on April 15, 2003, and the Decision On Petition dated November 19, 2003.

Also enclosed is a notice of Change Of Attorney's Correspondence Address. Please forward all further

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correspondence regarding this patent application to the address indicated on the enclosed notice.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Mark P. Stone". The signature is fluid and cursive, with the first name "Mark" and last name "Stone" being clearly legible, and "P." in the middle.

Mark P. Stone
Reg. No. 27,954
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 21

MARK P. STONE
1100 High Ridge Road
Stamford, CT 06905

NOV 19 2003

In re Application of:
David G. McCarthy
Serial No.: 08/951,276
Filed: October 16, 1997
Attorney Docket No.: 402-038-19

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.181, filed on April 15, 2003.

The petition is DENIED.

The petitioner requests that the decision in the Official Action dated March 7, 2003 be vacated.

A review of the record indicates that the Board of Patent Appeals and Interferences (BPAI) only adjudicated the matter of the rejection under 35 USC §112, 1st paragraph. The BPAI never adjudicated the rejection of the claims over prior art.

While the art rejection was withdrawn prior to the decision by the BPAI, no where in the record is it indicated that the claims were allowable over the prior art of record.

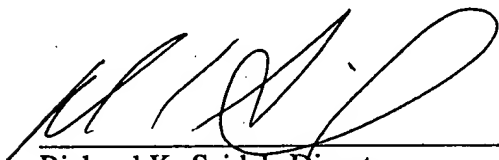
The Examiner has reopened prosecution and properly rejected the claims on new grounds, albeit using the same prior art, as pointed out by the petitioner. 37 CFR 1.198 states "Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of 37 CFR 1.114 or 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown." It is our contention that the new grounds of rejection under 35 USC §103 show sufficient cause to warrant the reopening of prosecution.

Accordingly, the petition is denied.

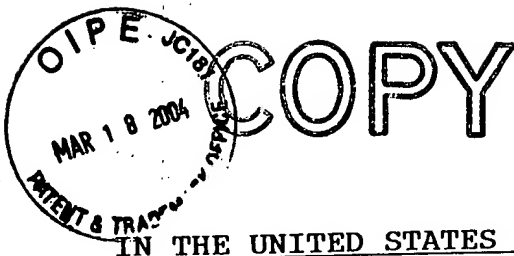
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Inquiries regarding this decision should be directed to Paula Bradley at (703) 308-2319.

The case will be forwarded to Examiner Hammond.

A handwritten signature in dark ink, appearing to read 'R. Seidel', is written over a horizontal line.

Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and
Optical Systems, and Components



402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy

Serial No. 08/951,276

Filed: October 16, 1997

Title: Retractable Receptacle
For Furniture

Commissioner for Patents
Washington, D.C. 20231

Attn: Box DAC
Office of Petitions

PETITION TO COMMISSIONER UNDER 37 CFR 1.181

I). INTRODUCTION

The above identified Applicant, by and through his undersigned attorney, hereby petitions the Commissioner under 37 CFR 1.181 to invoke his supervisory authority and vacate the decision in the Official Action dated March 7, 2003 by the Primary Examiner, the Supervisory Patent Examiner, and the Director of Technology Center 2800, re-opening prosecution of this application on the merits under 37 CFR 1.198 after decision by the Board of Patent Appeals & Interferences.

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(Date of Deposit)

Mark P. Stone
MARK P. STONE

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As more fully discussed herein, the re-opening of prosecution on the merits fails to comply with the express requirements set forth in 37 CFR 1.198.

II). STATEMENT OF FACTS

1). In a final action dated August 31, 1999, the Primary Examiner rejected Claims 1, 2, 6 and 16 under 35 U.S.C. Section 102(b) over the Byrne patent (U.S. Patent No. 4,747,788); rejected Claims 19 and 20 under 35 U.S.C. Section 102(b) over the Mitchell et al patent (U.S. Patent No. 4,511,198); and rejected Claims 3 - 5, 7 - 15 and 17 - 18 under 35 U.S.C. Section 103(a) over the Byrne patent (U.S. Patent No. 4,747,788). No claims were allowed.

2). On November 1, 1999, Applicant filed a Request For Reconsideration After Final Rejection;

3). In an Advisory Action dated November 16, 1999, the Examiner maintained the prior art rejection of the claims;

4). On December 2, 1999, Applicant filed a Notice of Appeal. Applicant's Appeal Brief which, inter alia, presented arguments rebutting the prior art rejections in the final action, was filed on January 19, 2000;

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5). In the Examiner's Answer dated April 11, 2000, all prior art rejections were withdrawn. Paragraph 6 of the Examiner's Answer expressly states: "The appellant's statement of the issues in the brief is correct; the rejections under 35 USC 102 and 103 are withdrawn.";

6). On October 31, 2002, the Board of Patent Appeals And Interferences reversed all outstanding grounds of rejection under 35 U.S.C. 112 raised against appealed Claims 1 - 20; and

7). In an Official Action dated March 7, 2003, the Examiner re-opened prosecution on the merits and rejected all of the appealed Claims 1 - 20 over the same two prior art references (U.S. Patent Nos. 4,747,788 and 4,511,198) which were applied in the final rejection dated August 31, 1999, and which were expressly withdrawn from the appeal in the Examiner's Answer dated April 11, 2000.

III). ARGUMENT -

37 CFR 1.198 states:

"Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of Section 1.114 or Section 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown".

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Applicant submits, based upon the facts set forth above, that the Examiner lacked authority under 37 CFR 1.198 to re-open prosecution on the merits after appeal and to apply the same prior art references expressly withdrawn by the Examiner in the Examiner's Answer prior to the decision on appeal.

37 CFR 1.198 imposes two requirements on cases re-opened after decision by the Board, namely, 1). that the case can be re-opened only for the consideration of matters not already adjudicated, and 2). that sufficient cause for re-opening prosecution be shown.

In the instant case, the Examiner has re-opened the prosecution for consideration of matters which have already been adjudicated by the Board. The express withdrawal of all prior art rejections in the Examiner's Answer based upon the two prior art patents applied in the final rejection, after Applicant had argued against these prior art rejections in his Appeal Brief, constitutes an adjudication of these rejections in Applicant's favor by default. Although the March 7, 2003 Official Action applies the same two prior art patents in a different manner than they were applied in the final rejection, the current rejections are nonetheless based on the identical prior art patents withdrawn by the Examiner during appeal. The Examiner had the authority to re-open prosecution to withdraw the prior art rejections in the final action based on the arguments advanced in Applicant's Appeal Brief and enter a new ground of rejection

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applying the two prior art patents in a different manner prior to the Board's decision on appeal (Manual of Patent Examining Procedure, 8th Edition, August 2001, Section 1208.02), but elected not to do so.

The withdrawal in the Examiner's Answer of the prior art rejections based on the two prior art patents applied in the final action in response to the arguments advanced in Applicant's Appeal Brief, and the failure by the Examiner to enter any new grounds of rejection based on these two patents prior to the decision on appeal, results in an adjudication in Applicant's favor, by default, that the appealed Claims 1 - 20 define patentable subject matter over these two prior art patents. The Official Action dated March 7, 2003, rejecting the same appealed claims over the same two prior art patents withdrawn in the Examiner's Answer, is therefore directed to matters already adjudicated by the decision on appeal, and prosecution on the merits cannot be re-opened under 37 CFR 1.198 to address these matters.

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The Official Action dated March 7, 2003 fails to show sufficient cause for re-opening prosecution on the merits, as expressly required by 37 CFR 1.198. In fact, the Official Action does not even address the issue of sufficient cause, nor acknowledge that the rejections being made are based upon the two

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identical prior art patents applied in the final action and thereafter expressly withdrawn in the Examiner's Answer during the appeal. The Examiner was clearly aware of the existence of the two prior art references applied in the March 7, 2003 Official Action before the decision of the Board on appeal and, as discussed above, could have re-opened prosecution on the merits to apply these two prior art patents in the manner applied in the March 7, 2003 Official Action prior to the Board's decision. Yet, the Official Action fails to make any showing or provide any explanation as to why the two prior art patents applied in the March 7, 2003 Official Action were not, or could not have been, applied by the Examiner to make the rejections first made in the March 7, 2003 Official Action before the decision by the Board on the appeal. Therefore, the Examiner has failed to make a sufficient showing for re-opening of prosecution on the merits after decision on appeal, as required by 37 CFR 1.198.

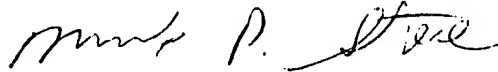
IV). CONCLUSION -

Applicant submits that the Official Action dated March 7, 2003, re-opening the prosecution after decision by the Board on appeal, fails to comply with the requirements of 37 CFR 1.198,

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and requests that the Examiner be directed to withdraw the prior art rejections of the claims made in the Official Action dated March 7, 2003.

Respectfully submitted,



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